

REMARKS**Summary of the Office Action**

Claims 1-2 and 4-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ito*, U.S. Patent No. 6,364,703 in view of *Hill*, U.S. Patent No. 5,547,388.

Summary of the Response to the Office Action

Applicants respectfully request reconsideration. Accordingly, claims 1-2 and 4-7 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 1-2 and 4-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ito* in view of *Hill*. Applicants traverse this rejection for the following reasons.

Applicants respectfully assert that neither *Ito* nor *Hill* teach or suggest at least “a packing protecting portion extending from a peripheral wall of an opening of said cover portion in a continual longitudinal direction,” as recited in claims 1 and 5.

Ito shows a sealed waterproof connector assembly for protecting electrical wires. The inner casing 10, outer casing 30, and elastic plug 20 form the water-proof connector housing, H. See the col. 4, lines 11-20 and Fig. 1 of *Ito*.

Hill shows a tethered protective cover which is detachably mounted to a multi-pin electrical connector. The cover includes a shroud which is mounted to the connector. A latch button on the intermediate shroud wall interacts with the projection on the connector to secure the shroud to the connector. See Fig. 4 and the Abstract of *Hill*.

Neither *Ito* nor *Hill*, either alone or in combination, discloses the above-mentioned features as recited in independent claims 1 and 5. Further, because neither *Ito* nor *Hill* disclose the above-mentioned features recited in claims 1 and 5, each and every feature of the claims is not disclosed and a *prima facie* case of obviousness has not been established.

Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness and therefore request that all rejections under 35 U.S.C. § 103(a) be withdrawn. To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

First, the Office Action does not establish a *prima facie* case of obviousness at least because it has not identified any suggestion or motivation to combine the cited reference teachings. Here, the suggestion or motivation to modify is not provided by either *Ito*, *Hill*, or by knowledge generally available to one of ordinary skill in the art, but only by impermissible hindsight. Applicants respectfully submit that there is no motivation to combine the references because the waterproof connector assembly of *Ito* would not function as originally intended (would not be waterproof) if improperly modified by *Hill* to include a front hole in its cover.

In fact, the Office Action erroneously combines *Ito* and *Hill* therein destroying the *Ito* reference. MPEP § 1504.03 states that “[i]f the proposed combination of the references so alters the primary reference that its broad function can no longer be carried out, the combination of the prior art would not have been obvious to a designer of ordinary skill in the art.” The

modification of *Ito* with the *Hill* reference effectively destroys the waterproof connector assembly function of *Ito*.

Ito discloses a waterproof connector for electrical wires. The sealed waterproof connector prevents any water or moisture from entering. The combination of *Ito* with *Hill* would destroy the *Ito* reference because *Hill* introduces a hole on the front of its cover. The hole, which is used to release the cover from its connector, would allow water and moisture to enter inside the cover and corrode the electrical contacts. Such a combination would destroy the *Ito* reference. As such, there is no motivation to combine the references. Therefore, it is respectfully submitted that the conclusory statement regarding motivation in the Office Action is not sufficient by itself to establish *prima facie* obviousness.

Second, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” See MPEP § 2143.01. The Office Action does not provide any citation to suggest the desirability of modifying *Ito*. The mere assertion that *Ito* could be modified by what is ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness.

Third, as demonstrated above, independent claims 1 and 5 disclose features not taught or suggested by either *Ito* or *Hill*. That is, neither *Ito* nor *Hill* teach or suggest at least “a packing protecting portion extending from a peripheral wall of an opening of said cover portion in a continual longitudinal direction,” as recited in claims 1 and 5. For at least these reasons, Applicants respectfully submit that claims 1 and 5 are allowable.

Claims 2 and 4, and 6-7 are allowable at least because they recite the same combination of features as independent claims 1 and 5, respectively, as well as additional features that further distinguish them over the applied prior art. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

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